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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/315,822	05/21/1999	SCOTT N. CHRISTENSEN	24122-403	6988

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/315,822

Applicant(s)

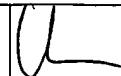
CHRISTENSEN, SCOTT N.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Continued Prosecution Application***

The request filed on August 28, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d), along with a Petition For Revival of the Instant Application for Unintentional Abandonment under 37 CFR 1.137(b), based on parent Application No. 09/315,822, is acceptable and a CPA has been established accordingly. An action on the CPA is submitted below.

**DETAILED ACTION**

***Specification***

On page 52, line 3, "... on conjunction ..." should apparently be --... in conjunction ...--.

On page 52, line 24, "... to generated ..." should apparently be --... to generate ...--.

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed.

The abstract of the disclosure is too long, that is more than 150 words or 15 lines.

(See 37 CFR 1.72).

Regarding the IDS, the Applicant needs to provide copies of the NPL documents, as shown on PTO forms 1449. In the meantime, only the Examiner will consider the US Patents and PCTs. Although the Applicant claimed that all NPL documents were submitted with continuation

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Application 09/323,240, the Examiner could not locate them especially since Application 09/323, 240 had been abandoned.

### **Status of the Claims**

Claims 1-10 are currently pending in the Instant Application.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities:

As per claim 4 (claims 4-5), line 6, "... deemed ..." should apparently be -- ... redeemed ... --.

Appropriate correction is requested.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 recites, in line 2, the limitation "... said **remote** database ...". There is insufficient antecedent basis for this limitation in the claim. For examination purpose, the Examiner assumes that the Applicant meant to refer to -- ... said database ....-- or --... said remote computer network ....--.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (hereinafter Barnett), US Patent 6, 321, 208B1.

As per claim 1, Barnett discloses a system for distributing in an interactive manner over a computer network or the Internet by an online service provider 2 of fig. 1 electronic coupons (Virtual coupons) received from coupon issuer 14 or coupon distributor 16 to registered users using remote computers 6 of fig. 1 wherein a central repository or database 40 of fig. 6 associated with online service provider 2 stores electronic coupon packages and a database file 42 stores users' demographic data or profile data (name, address, income, etc.), provided by the users during an online registration process with the online service provider 2, and survey responses given by the users. First, a user initially visits the online service provider 2 web site and downloads or accesses generic or untargeted electronic coupons or coupon data stored in database 40 and the demographic data collected from the user during the initial visit (registration process) are used to target specific coupon data packages for subsequently downloading by the user. It is further understood that those specific coupon data packages generated for the user or

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specific user are stored in the database 40 of the online service provider 2 along with uniquely created user-specific identification indicia uniquely identifying the user or customer using or participating in the online coupon distribution system (col. 7: 55 to col. 8: 5; Claim 1 of the current reference). Once the user joins the online coupon distribution system subsequent to the registration process during the initial visit, the user can connect or access or log into, by inputting via a keyboard his identification number or user-specific ID and/or login name, the online service provider 2 system having an associated web site where the said user can download (request) from database 40 of the online service provider 2 targeted coupon data, specifically directed to his attention, to his personal computer 6 where the coupon data can be stored in a local database 30 of fig. 2 or used by the user to print one or more coupons 70 as shown in fig. 5 using a printer 8 attached to the user's computer 6 (col. 8: 22-37; col. 8: 46-47; col. 6: 50 to col. 7: 11; col. 9: 33-52). The one or more printed coupons are presented for redemption in the normal or conventional fashion by the specific user or customer when shopping at a desired retailer. Following the redemption process, the redeemed coupon data are transmitted by the desired retailer to a coupon redemption center 13 where they are electronically read and the user-specific data are recorded in a coupon redemption database (D/B) 12. Additionally, the user's transaction data including the redeemed coupon data (redemption data) are provided to the coupon issuers 14 and coupon distributors 16 of fig. 1 for integration into further marketing analysis; in other words, the coupon issuers 14 and coupon distributors 16 of fig. 1 utilize the user-specific data (coupons deleted, coupon printed and demographic data) along with the redemption data to generate or compile subsequent coupon packages targeted specifically or

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directed to the user's attention (using redemption data to update the user's virtual coupons or electronic coupons) (See abstract; col. 6: 58-65; col. 7: 12-20; col. 7: 45-55).

As per claim 2, Barnett discloses an online coupon distribution system, wherein once a user joins the online coupon distribution system subsequent to the registration process, the user can connect or access or log into, by inputting via a **keyboard** his identification number or user-specific ID and/or login name, the online service provider 2 system having a web site where the said user can download (request) from **database 40** targeted coupon data, specifically directed to the user's attention, to his computer where the coupon data can be stored in a local database 30 of fig. 2 or used by the user to print one or more coupons 70 as shown in fig. 5 using a printer 8 attached to the user's computer 6 (col. 8: 22-37; col. 8: 46-47; col. 6: 50 to col. 7: 11).

As per claims 3 and 6, Barnett discloses an online coupon distribution system wherein, during a registration process, the user using personal computer 6 can transmit data such as demographic data, via a **computer network or the Internet or data link 4 of fig. 1**, to the online service provider 2, which stores the demographic data in a database file 42 of fig. 6 and, once registered, the user can also receive data, such as targeted electronic coupon or virtual coupon data, from the online service provider 2, which stores the electronic coupon data in database 40 or central repository. In another embodiment, it is contemplated that coupon issuers 14 and coupon distributors 16 can also transmit electronic coupon data, via the computer network or Internet or data link 4 of fig. 1, to online service provider 2 of fig. 1 where they can

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be downloaded by the user or users (See abstract; col. 6: 52 to col. 7: 5; col. 7: 56 to col. 8: 5; col. 9: 33-52).

As per claim 4, Barnett discloses an online coupon distribution system wherein the user is allowed to print a particular coupon only **once**, good for a one-time redemption, thus providing for security and guarding against fraudulent redemption since any subsequent attempt to redeem the same printed coupon or a duplicate by a user will exceed the number of times the printed coupon can be redeemed (tracking or counting system) (col. 11: 11-23; col. 11: 44-50).

As per claim 5, Barnett discloses an online coupon distribution system wherein a printed coupon printed by the user comprising a bar code 90 representing a user's unique identification number such as his social security number and/or online service address or e-mail address, the UPC bar code 84 and number 82 of the product associated with the particular printed coupon, redemption instructions 88, the coupon value 74 and so on and so forth (fig. 5; col. 7: 21-32).

As per claims 9-10, Barnett discloses an online coupon distribution system wherein one or more printed coupons are presented by the user for redemption in the normal or conventional fashion when shopping at a desired retailer. Following the redemption process, the redeemed coupon data are transmitted by the desired retailer to a coupon redemption center 13 where they are electronically read and the user-specific data are recorded in a coupon redemption database (D/B) 12. Further, the user's transaction data including the redeemed coupon data (redemption data) are provided to the coupon issuers 14 and coupon distributors 16 of fig. 1 for integration



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into further marketing analysis. In order words, the issuers 14 and coupon distributors 16 of fig. 1 utilize the user-specific data (coupons deleted, coupon printed and demographic data) along with the redemption data to generate or compile subsequent coupon packages targeted specifically at certain user categories or selected categories of products. It is further contemplated that the coupon issuers 14 and coupon distributors 16 can use the user's transaction data including the coupon redemption data in many ways without impacting the functionality or utility or operation of the system. For example, as implicitly supported in the current reference, the coupon issuers 14 and coupon distributors 16 can use the user's transaction data including the coupon redemption data to further generate more targeted coupons or fewer targeted coupons or simply update electronic coupon data specifically directed to the user's attention, wherein these coupons are redeemable on a selected category of products (See abstract; col. 6: 58-65; col. 7: 12-20; col. 7: 45-55).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett, US Patent 6, 321, 208 B1 in view of Official Notice.

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As per claims 7-8, although Barnett teaches an online coupon distribution system for allowing a user to initially visit the online service provider 2 web site and download or access generic or untargeted electronic coupons or coupon data stored in database 40 while, at the same time, collecting from the user demographic information, during a registration process, used by the coupon issuers 14 and coupon distributors 16 to generate specific coupon data packages for subsequently download by the user, he does not expressly disclose providing to the user a computer diskette containing data, from the computer network, used by the user to access the system.

However, providing a Software or a tool encoded on a computer readable medium to a user or customer which, when installed on the user's computer, allows the user to access an online distribution system or a computer network, such a LAN, WAN or the Internet, is a well-established business method practiced in the industry for many years. In fact, Internet Service Providers or ISPs, such as AOL (America Online), have been distributing free software encoded on 1.44 floppy diskettes to selected users. The diskette mailed by AOL, for example, bears a temporary login name and password or identification. Upon installing the software, encoded on the diskette, on his computer, a user will be prompted to enter the temporary login name and password or identification, which allow the user to connect via a telephone line to a remote server associated with the ISP or AOL, wherein, upon validating the user's temporary information imprinted on the diskette, the user can complete the installation or registration process by providing his demographic data including a credit card number for future billing and establishing a login name or screen name and a password or identification. Subsequent to the

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installation or registration process, the user, now registered, can browse the ISP site or visit other sites or web sites available on the Internet. Finally, the registered user can, at any time, use his established login name and password to connect to the Internet, via the ISP, or to read or send e-mails or browse for local content available at the ISP site.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above publicly known disclosure (Official Notice) into the Barnett's online coupon distribution system so as to mail out or distribute free software encoded on 1.44 floppy diskettes, having imprinted thereon a temporary login name and password or identification, to selected users, based on their general demographic profile, wherein, upon installing the free software on his computer, a selected user will be prompted to enter the temporary login name and password or identification, which allow the user to connect via a telephone line to a remote server, connected to a computer network or LAN or WAN or the Internet, associated with the online service provider 2 of fig. 1 or online coupon distribution system where he can access or download pre-selected coupon data in accordance with the user's general demographic profile, while at the same time collecting from the user during an online registration process a more detailed demographic profile and a survey response related to survey questions from the online service provider 2, thereby encouraging the user to support local stores where he can redeem his coupons, while providing the coupon redemption data, the more detailed demographic profile and the response to the survey questions to the coupon issuers 14 and the coupon distributors 16 for generating more targeted coupons specifically directed to the user's attention (col. 6: 29-65)..

### **Conclusion**

Although the following references were not officially used in the prosecution of the Instant Application, they were highly considered as relevant prior art. Applicants are further advised to consult these references.

US Patent 6, 014, 634A to Scroggie et al. discloses a system for providing an electronic incentive to a user who can download coupon data from a web site and obtain a hard copy of a coupon by using a printing device.

US Patent 5, 717, 923A to Dedrick discloses providing a software tool to a user for allowing the user to participate in an online advertising distribution system (col. 3: 37-67).

US Patent 5, 855, 007A to Jovicic discloses an electronic coupon distribution and communication system.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

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After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

**Please provide support, that is page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.**

JDJ

04/02/03



Jean D. Janvier  
Patent Examiner  
Art Unit 3622